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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/977,298 | 10/16/2001 | Ryuichiro Maeyama | 110894 | 4681 |
| 25944 | 7590 | 04/28/2004 | EXAMINER | |
| OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320 | | | KRUEER, KEVIN R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1773 | |

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------|-------------------------------|--|--|
| Advisory Action | Application No. 09/977,298 | Applicant(s) MAEYAMA ET AL  | |
| | Examiner Kevin R Kruer | Art Unit 1773 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 1 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1-25.

Claim(s) objected to: _____.

Claim(s) rejected: 9-16, 19-21, 24 and 25.

Claim(s) withdrawn from consideration: 1-8, 17, 18, 22, and 23.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Advisory Action

The proposed amendment filed March 26, 2004 has been fully considered. The amendment will not be entered because it would require further search and/or consideration. Specifically, the amendment to claim 21 would require that the transferer and the transfer-fixing unit are the same member. Furthermore, the proposed amendments are not deemed to place the application in better form for appeal by materially simplifying and/or reducing the issues for appeal. Applicant has not demonstrated that the proposed amendments would make the claims allowable over the prior art.

With respect to the rejection of claims based upon the teachings of Saeki in view of Buchan, Applicant argues the intermediate transfer belts taught in Saeki and Buchan are not analogous. Specifically, the intermediate transfer belt taught in Saeki is not used to fix the toner image onto a transfer material, whereas the intermediate transfer belt of Buchan not only transfers toner but also fixes such toner image upon the surface of the transfer material. Applicant argues that one of ordinary skill in the art would not have been motivated to apply a metal thin film upon a surface of the intermediate transfer belt of Saeki because said belts are not used for the same purpose. The examiner respectfully disagrees. Buchan teaches that the metal thin film is applied to improve the heat absorption of the intermediate transfer belt (col 4, lines 1+). There is nothing on record that suggests that heat transfer is an issue only in intermediate transfer belts that are used to both transfer and fix the toner to a transfer material.

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Thus, the examiner maintains the position that the teachings of Saeki and Buchan render the pending claims obvious.

Applicant further argues that Saeki completely fails to indicate that the amount of carbon black included in the layer of the intermediate transfer belt would be effective to form an electrode on the surface. However, Applicant neither discloses nor shows that the surface must contain a certain amount of conductive matter before the conductive matter is considered to form an electrode. Thus, the examiner maintains the position that Saeki reads on the claimed film with conductive material biased to one surface.

With respect to Saeki in view of Goto, Applicant argues that Goto enumerates several problems associated with transfer belts with electroconductive layers on the back of the belt. Applicant argues that such known disadvantages would naturally discourage search for new inventions may be taken into account in determining obviousness. The examiner acknowledges that such known disadvantages have to be taken into account when determining obviousness, but maintains the position that the teachings of Goto rendered the claims obvious because Goto acknowledges advantages of applying an electroconductive layer to an intermediate transfer belt. Specifically, said layer improves the belt's resistance to the charge-up problem typically seen in transfer belts.

Applicant further argues that the claimed invention requires the presence of the metal thin film on the fixing belt without an intervening adhesive. However, the examiner notes that the combination of references does not contain an intervening

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adhesive layer. Specifically, Goto teaches that the electroconductive layer is vapor deposited on the inner layer of the transfer belt (col 2, lines 39+).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin R. Kruer
Patent Examiner-Art Unit 1773



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700